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10/598,457	12/19/2006	Daijiro Nakamura	020872-9009-03	5698
60840 7590 04/27/2009 MICHAEL, BEST & FRIEDRICH LLP 100 EAST WISCONSIN AVENUE SUITE 3300 MILWAUKEE, WI 53202				
EXAMINER				
HOLMES, JUSTIN				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/598,457

**Applicant(s)**

NAKAMURA, DAIJIRO

**Examiner**

JUSTIN HOLMES

**Art Unit**

3655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/IC)
- Paper No(s)/Mail Date 6/25/08, 12/19/07, 12/19/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-6 are pending.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on June 25, 2008, December 19, 2007 and December 19, 2006 are being considered by the examiner.

#### ***Drawings***

4. The drawings were received on August 31, 2006. These drawings are acceptable.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Publication No. 2002/0130007 to Nakamura et al.

The Nakamura et al. patent teaches a rotation output device, comprising: an output conveyance mechanism 10 including a rotation driving member M for outputting a rotation driving force and a rotation output member 11 for outputting a rotation force in response to the driving of the rotation driving member 28, which are coaxially connected to each other so as to convey the rotation force, with a predetermined play angle  $\alpha$  to which the rotation force is not conveyed being formed in a relative rotation direction; and a lock mechanism 10 including a movable lock member 24 for locking a rotation conveyed from the rotation output member by being pressed toward a fixing member 27 by the rotation output member 11, wherein the rotation output member 11 and the fixing member 27 located on an outer circumferential surface of the rotation output member and rotational-fixed are provided to face each other while being separated by a predetermined distance in a radial direction; a lock operation member 23 operable to press the movable lock member 24 toward the fixing member 27 by the rotation conveyed from the rotation output member 11; and a release member 21 capable of releasing the pressed state of the movable lock member 24 by the rotation conveyed from the rotation driving member 28 and thus capable of releasing the locked state; wherein retaining means 22 is provided, between the movable lock member and the fixing member, for retaining the position of the movable lock member in the rotation direction when receiving the rotation from the rotation output member. See Figs. 3-7.

Regarding claim 2, the retaining means 22 is formed of a contact member 44 integrally rotatable with the movable lock member 24 and partially contacting the fixing

member 27. The retaining means 22 contacts the fixing member 27 through the protrusion 41 of the releasing ring 21. See Fig. 7.

Regarding claim 3, a plurality of the movable lock members 24 are provided, and the plurality of movable lock members are integrally rotatable with one another by one contact member 44. The contact member is one piece in that it is integrally formed as one piece of the retaining means 22. See Fig. 6.

Regarding claim 6, an electric tool uses the output device. See Fig. 2.

7. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,063,201 to Nakamura et al.

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The Nakamura et al. patent teaches a rotation output device, comprising: an output conveyance mechanism including a rotation driving member M for outputting a rotation driving force and a rotation output member for outputting a rotation force in response to the driving of the rotation driving member 28, which are coaxially connected to each other so as to convey the rotation force, with a predetermined play angle  $\alpha$  to which the rotation force is not conveyed being formed in a relative rotation direction; and a lock mechanism 110 including a movable lock member 224 for locking a rotation

conveyed from the rotation output member by being pressed toward a fixing member 127 by the rotation output member, wherein the rotation output member and the fixing member located on an outer circumferential surface of the rotation output member and rotational-fixed are provided to face each other while being separated by a predetermined distance in a radial direction; a lock operation member 123 operable to press the movable lock member 224 toward the fixing member 127 by the rotation conveyed from the rotation output member; and a release member 121 capable of releasing the pressed state of the movable lock member 224 by the rotation conveyed from the rotation driving member and thus capable of releasing the locked state; wherein retaining means 147 is provided, between the movable lock member and the fixing member, for retaining the position of the movable lock member in the rotation direction when receiving the rotation from the rotation output member. See Figs. 26a and 26b.

Regarding claim 2, the retaining means 147 is formed of a contact member 131 integrally rotatable with the movable lock member 224 and partially contacting the fixing member 127. See column 20, lines 14-23.

Regarding claim 3, a plurality of the movable lock members 224 are provided, and the plurality of movable lock members are integrally rotatable with one another by one contact member 123. See Fig. 26b.

Regarding claim 4, sliding resistance increasing means for increasing a sliding resistance is provided at a position where the contact member contacts the fixing member. See column 20, lines 39-53.

Regarding claim 5, the sliding resistance increasing means is formed of an elastic member 126. See column 20 lines 39-65.

Regarding claim 6, an electric tool uses the output system. See Fig. 1-2a.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1--20 of U.S. Patent No. 7,063,201 to Nakamura et al. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the structure claimed can be interpreted as reading on the current application claims.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 4,804,048 to Porth, Jr. and U.S. Patent No. 6,010,426 to Nakamura both teach various locking mechanisms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN HOLMES whose telephone number is (571)272-3448. The examiner can normally be reached on 8:00am to 4:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JUSTIN HOLMES/  
Examiner, Art Unit 3655

/Rodney H. Bonck/  
Primary Examiner, Art Unit 3655